

### REMARKS

Applicants understand that the Restriction Requirement has been made final, but Applicants respectfully request that the non-elected claims be permitted to remain pending in the application until Applicants are able to file divisional applications to the non-elected subject matter claiming the benefits afforded by 35 USC §120 and 121.

In the foregoing Amendment, Applicants have corrected the grammar objected to in claim 24 and furthermore have amended claim 22 to specify that the heat treating actually causes the silicate to become less soluble in water. In view of the foregoing amendments, withdrawal of the claim objection and the rejection under 35 USC §112, second paragraph, is respectfully requested.

Reconsideration of the previous rejection of claim 22 under 35 USC §102(b) as being anticipated by Lilla is respectfully requested.

Initially, Applicants respectfully requested the Examiner to identify whether Lilla is being used an explicit anticipatory reference or whether the Examiner is relying on inherency in alleging anticipation by Lilla.

Although Applicants are aware of the Examiner's paraphrase of Lilla, Lilla does not in fact make the sodium silicate solution less soluble in water by applying heat. Rather, as clearly disclosed by Lilla at column 2, lines 12-14, Lilla teaches that "the water soluble silicate and (after applied) soluble metal salts are then allowed to react to form a hydrated, water insoluble metal silicate and a void". Although Lilla does disclose the use of heat to "drive" a soluble composition into the wood material; see column 2, lines 44-50, Lilla makes it clear that it is the resulting reaction between the sodium meta-silicate and calcium chloride will take place if ambient conditions allow. As expressly recited in the Applicants' claim 22, not only is "heat treating" achieved to dehydrate (or dry) said

silicate solution to form a soluble silicate substance, but "further heat treating of said soluble silicate to cause the soluble silicate to become less soluble in water" as accomplished with second heat treating is not disclosed at all in Lilla.

Applicants respectfully submit that Lilla cannot possibly act as an anticipatory reference under 35 USC §102(b) because it does not expressly or inherently teach the expressly recited steps of Applicants' claim 22. Accordingly, withdrawal of the rejection is respectfully requested.

Reconsideration of the previous rejection of claims 22-24 of the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4-5 of US Patent No. 6,040,057; or alternatively, over claim 1 of US Patent No. 6,146,766 as "is shown by the description by the Applicant" is respectfully traversed. It is noted that neither rejection of the claims represent a true "double patenting" under 35 USC §101. Accordingly, implicit, though not explicitly stated by the Examiner, is the fact that there are differences between the claims of the cited patent and the claims of the instant application.

In order to attempt to sustain the rejection, the Examiner relies upon the "description by the Applicant" or the "Abstract" of the cited patents in order to sustain the rejection.

Applicants remind the Examiner that the "description by the Applicant" is not part of the prior art which would be available to the Examiner in order to establish that the instant claims are "obviousness-type" over the claims of the cited patents. It is further noted that the effective filing date of the "description by the Applicant" predates the filing date of either of the two cited patents such that "at the time the invention was made" it would not have been obvious to one skilled in the art to do what Applicant has done.

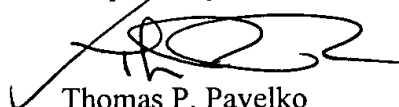
Furthermore, Applicants note that the Examiner is incorrect in relying upon the abstract of either US Patent No. 6,040,057 or 6,146,766 in attempting to support this rejection. The text of these patents is not available as "prior art" to the instant application which predates the effective filing date of each of the cited patents. Thus, it is only the claims which the Examiner can look to of the cited patents to support the obvious-type double patenting rejection and, without the impermissible use of the Applicant's own disclosure (or later we disclose if not properly part of the prior art) can the Examiner hope to allege that a prima facie case of obviousness-type double patenting has been made out.

For the foregoing reasons, withdrawal of the rejection of claims 22-24 on the judicially created doctrine of obviousness-type double patenting is respectfully requested.

Having fully responded to the previous Office Action, favorable reconsideration and withdrawal of the rejections and indication of allowable subject matter is respectfully requested.

If any additional fee is necessary to make this response timely, Applicant hereby petitions for a three-month extension of time and authorizes that the charge of any petition fee or any other fees may be made to the undersigned's Deposit Account No. 19-4375.

Respectfully submitted,



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TPP/kag  
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22. (Amended) A process for increasing fire resistance of a combustible material comprising:

contacting a porous combustible material with a soluble silicate solution under conditions so as to impregnate pores within the combustible material with said silicate solution;

heat treating said impregnated combustible material at an elevated temperature to dehydrate said silicate solution to form a soluble silicate substance within the pores of said combustible material and further heat treating said soluble silicate within said pores to [tend to] cause said soluble silicate to become less soluble in water.

24. (Amended) A process of imparting fire retardant and moisture resistant properties to a cellulosic material comprising applying and infusing a material consisting of [an] a sodium silicate solution, applying energy to said material under sufficient conditions to thereby cause the alkali metal silicate to become water insoluble.